

R E M A R K S

Claims 1 to 6, 8 to 16 and 28 to 33 as set forth in Appendix II of this paper are now pending in this case. Claim 7 has been canceled, and Claims 1, 28 and 31 have been amended, as indicated in the Listing of Claims set forth in Appendix I of this paper.

Accordingly, section (b) of Claims 1 and 28 has been amended to include the provisions of Claim 7. Additionally, the phrase "as defined in claim 23" in the preamble of Claim 31 has been replaced by the definition previously provided by Claims 20 and 23. No new matter has been added.

The Examiner has rejected Claims 1 to 16 under 35 U.S.C. §103(a) as being unpatentable in light of the disclosure of *Musaeus et al.* (EP 498 824). In this context, the Examiner particularly points out that *Musaeus et al.* provide for a process of preparing a powdered solid which is dispersible in water or an aqueous solution by milling a solid such as a carotenoid in the presence of a hydrocolloid.

It is respectfully added that the powdered solid is, in accordance with the teaching of *Musaeus et al.*, obtained from the dispersion which is formed in the milling stage, by "drying the suspension"¹⁾. *Musaeus et al.* further explain that the suspension is dried by "conventional methods such as spray cooling, spray drying, modified spray drying or sheet drying and crushing, etc."²⁾.

In contrast to the process disclosed by *Musaeus et al.*, applicants' invention requires the stages of

- flocculating the protecting colloid together with the active compound out of the dispersion by adjusting the pH of the dispersion to a value which is in the range of the isoelectric point of the protein which is employed as protecting colloid,
- subsequently separating off the flocculated solid from the liquid phase, and
- finally converting the flocculated solid into a dry powder.

The teaching of *Musaeus et al.* neither suggests nor implies a separation of the solid from the liquid phase which comprises flocculating

1) Note, for example, col. 2, indicated lines 50 to 58, particularly lines 57 and 58, of EP 498 824.

2) Note, for example, col. 4, indicated lines 30 to 33, of EP 498 824.

by adjusting the pH of the dispersion. As such, the teaching of *Musaeus et al.* fails to teach or suggest all of the limitations which characterize applicants' invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success, and, finally, the prior art reference must teach or suggest all the claim limitations. Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and cannot be based on applicant's disclosure³⁾. Accordingly, the mere fact that the prior art can be modified in some manner so as to arrive at a claimed invention does not support a conclusion of obviousness where the prior art fails to suggests the desirability of the specific modification which is required⁴⁾.

Since the teaching of *Musaeus et al.* fails to teach or suggest all of the limitations which characterize applicants' process, and also fails to suggests the desirability of the specific modification which is necessary to arrive at the particularities of applicants' invention, the teaching of *Musaeus et al.* cannot be considered to render the subject matter of applicants' Claims 1 to 16 *prima facie* obvious within the meaning of Section 103(a). Favorable reconsideration of the Examiner's position and withdrawal of the rejection of Claims 1 to 16 is, therefore, respectfully solicited.

The Examiner has rejected Claims 28 to 31 as being unpatentable in light of the disclosure of *Stein et al.* (EP 937 412). *Stein et al.* disclose a process which is, with regard to the separation of the powdered solid from the dispersion, essentially identical with the teaching provided by *Musaeus et al.* According to *Stein et al.*'s disclosure, organic solvents are initially removed⁵⁾ by evaporation⁶⁾, and the remaining aqueous dispersion is subsequently converted into

3) In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (CAFC 1991)

4) ie. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (CAFC 1984); see also, eg., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985)

5) Note, for example, col. 2, indicated line 14, of EP 937 412.

6) Note, for example, col. 3, indicated lines 56 and 57, of EP 937 412.

the pulverized preparation⁷⁾ by way of spray drying or by using powder catch technique⁸⁾. The teaching of *Stein et al.* neither suggests nor implies a separation of the solid from the liquid phase which comprises flocculating by adjusting the pH of the dispersion. As such, the teaching of *Stein et al.* fails to teach or suggest all of the limitations which characterize applicants' invention. Under the rationale developed by the courts for a determination of obviousness under Section 103(a) which is addressed in the foregoing, the disclosure of *Stein et al.* therefore equally cannot be considered to render the subject matter of applicants' Claims 28 to 31 prima facie obvious within the meaning of Section 103(a). Favorable reconsideration of the Examiner's position and withdrawal of the rejection of Claims 28 to 31 is respectfully solicited.

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Respectfully submitted,
KEIL & WEINKAUF



Herbert B. Keil
Reg. No. 18,967

1350 Connecticut Ave, N.W.
Washington, D.C. 20036
(202) 659-0100

Encl.: THE LISTING OF CLAIMS (Appendix I)
THE AMENDED CLAIMS (Appendix II)

HBK/BAS

7) Note, for example, col. 2, indicated line 15 and 16, of EP 937 412.

8) Note, for example, col. 3, indicated line 57, to col. 4, indicated line 2, of EP 937 412.